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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,312	11/26/2001	Koji Taniguchi	MAT-8204US	8396
7590 01/12/2006				
RATNER AND PRESTIA		EXAMINER		
Suite 301		MCALLISTER, STEVEN B		
One Westlakes, Berwyn				
P.O. Box 980		ART UNIT		
Vally Forge, PA 19482-0980		3627		
DATE MAILED: 01/12/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/994,312		TANIGUCHI ET AL.	
	Examiner		Art Unit	
	Steven B. McAllister		3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6,9-15,18-24,27 and 40 is/are pending in the application.
- 4a) Of the above claim(s) 10-15,19-24,28-33,39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims rejected are 3-
6,9,18,27.34,28.34,29.34,30.34,31.34,32.34,33.34,34.34,35.34,36.34,37.34 and 38.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/28/2005 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 18 recites only a program which is not claimed as embedded on a tangible medium. Functional data not embedded on a tangible medium is per se non-statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18, 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18 and 27 are indefinite because it is not clear what information is strictly in the preamble and which information is positively claimed in the body of the claim. It's not clear what claimed actions the program causes the system to perform.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3, 4, 6, 9, 18, 27, and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florance et al (2003/0078897) in view of Nikolovska et al (6473,751).

Florance shows storing a request for delivery of content (e.g., request for notification of a house meeting certain criteria), the request provided by a user and having a delivery validity period comprising the subscription period (during which content is accepted and after which it is not), the address of the user, a content attribute comprising e.g., a type or category of property, and a content identifying information; extracting the delivery request within the validity period; selecting content conforming to

the attribute from a content management database; generating transmit data, including the content identifying information and content; and delivering the transmit data (comprising e.g., notification of a house as shown in par. 0089) if within the delivery validity period, and stopping delivery outside of that period (i.e., once the subscription has expired).

Florance does not show that the identifying information comprises an arbitrary string specified by the user.

Nikolovska shows providing identifying information comprising an arbitrary string specified by the user wherein the arbitrary string is a name given to the criteria by the user (see col. 9, lines 10-15). It would have been obvious to one of ordinary skill in the art to modify the method of Florance by having the user supply the content identification information, comprising providing a name, in order to provide an easy to remember way to identify the content.

As to claim 6, Florance in view of Nikolovska shows all steps except providing advertising content to the content according to the information about the billing form. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. For instance, it is notoriously old and well known to provide web service or email at a reduced or free price relative to the fee normally charged in return for placing advertisements in the content. It would have been obvious to one of ordinary skill in the art to further modify the method Florance by providing such an option in order to enhance revenue via advertisements and maximize the number of users.

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As to claim 9, Florance in view of Nikolovska shows all elements of the claim including deleting the delivery request when it is past the delivery validity period (i.e., subscription period), since the delivery request must be deleted in order to avoid sending information once the subscription has expired.

Alternatively as to claim 9, Florance shows all except deleting the delivery request when it is past the delivery validity period. However, the examiner takes official notice that it is notoriously old and well known in the art for the system to delete the delivery request after the delivery validity period. It would have been obvious to one of ordinary skill in the art to do so in order to avoid sending unwanted emails and to protect the value of the information which is only available by subscription.

As to claims 18 and 27, it is noted that Florance in view of Nikolovska shows software and hardware performing all recited steps.

As to claim 34, Florance and Nikolovska shows a delivery registration unit capable of storing a request for delivery and a content delivery unit as claimed.

As to claim 35-37, Florance in view of Nikolovska shows a program delivery unit capable of delivering to an arbitrary terminal a program performing all recited steps.

As to claim 38, Florance in view of Nikolovska shows all elements.

Alternatively, as to claim 38, Florance shows all steps except a content registration unit capable of accepting content and a request to deliver from an arbitrary server. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art

to further modify the apparatus of Florance by providing such a content registration unit in order to accept information regarding properties from a plurality of sources.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Florance in view of Nikolovska as applied to claim 3 above, and further in view of Sealand et al (2003/0014402).

As to claim 5, Florance in view of Nikolovska shows including the content data in an email generated by the system. Florance in view of Nikolovska does not explicitly show placing the content identifying information in the header. Sealand shows this step. It would have been obvious to one of ordinary skill in the art to further modify the method of Florance by providing the content identifying information in the header in order to provide quick identification of the contents of the message.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (571) 272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister

Steven B. McAllister
Primary Examiner
Art Unit 3627

STEVE B. MCALLISTER
PRIMARY EXAMINER